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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,736

11/07/2006

Syuichi Oka

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08/12/2009

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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

08/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,736	Applicant(s) OKA ET AL.	
	Examiner DAVID LUKTON	Art Unit 1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23, 25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-23, 25 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/09</u> . | 6) <input type="checkbox"/> Other: _____ |

Pursuant to the response filed 6/12/09, claims 13, 25, 28-30 have been amended.

Claims 13-23, 25, 28-30 are now pending.

Applicants have argued that they have provided a copy of PCT/IB/304, and that this is tantamount to providing the documents to which foreign priority has been claimed. However, the examiner disagrees with applicants' assessment. What applicants have provided is a single page of a document, and that page is one of many that may have been filed as part of the filing for application PCT/JP2005/005677.

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Applicants' arguments filed 6/12/09 have been considered and found persuasive in part. The rejections of claim 24 are rendered moot by its cancellation.

Claims 28-29 are examined in this Office action; claims 13-23, 25, 30 are withdrawn.

△

Claim 28 remains objected to. If applicants are going to recite the formula that is now present (Gly-Pro-Ile-Gly-Xaa), a sequence ID number will have to be provided for that sequence. However, if applicants would prefer not to submit a new sequence listing, applicants can simply make reference to SEQ ID NOS: 3 and 4.

△

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-29 are rejected under 35 U.S.C. §102(b) as being anticipated by Venta (USP 6074832).

Venta discloses SEQ ID NO:2. Beginning at residue 1250 (col 29), the subsequence **GPIGS** is present. Venta does not teach this pentapeptide *per se*, only as a subsequence of a larger peptide.

The issue here concerns the meaning of the term “having” in claim 28. The term “having”, when applied to a peptide, can be interpreted to mean that any number of amino acids can be added to the N- or C-terminus. As such, the rejection is justified.

Either of the following could be used in a claim:

A water-soluble peptide consisting of GPIGS (SEQ ID NO: 3) or GPIGT (SEQ ID NO: 4).

- or -

A water-soluble peptide selected from SEQ ID NO: 3 and SEQ ID NO: 4.



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Claim 28 is rejected under 35 U.S.C. §102(b) as being anticipated by Okado (USP 6,015,689). Okado discloses SEQ ID NO:10. Beginning at residue 621, the subsequence **GPIGT** is present. The same argument as above (the §102(b) over Venta) applies here as well.



As indicated previously, the references that are published in Japanese have been stricken from the IDS. In response to this, applicants have expressed their opinion that the current format of the IDS can **only** be interpreted to mean that the examiner has not considered the foreign language documents at all, but has instead considered just the corresponding abstract. The examiner disagrees. Consider, for example, reference “AJ”, which is JP 2002-326913. On the IDS, under the column labeled “Translation, yes/no” the word “abstract” is present. If this examiner were to initial next to reference “AJ”, this could easily be interpreted to mean that the examiner is asserting that he has considered the text of the full document, when in fact this is not the case. The objective of the examiner is clarity of the record, and the complete absence of ambiguity with regard to which documents have been considered **in full**, and which have been considered **in part**. To use reference “AI” as an example, the following format can be used:

Abstract of Yoshikawa (WO 00/29425; issued 5/25/00).

Applicants have also argued that document GB 2321852 is the same as JP 10-279501. If it is really true that these two documents are indistinguishable, it would seem that there is little purpose to considering both of them.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654